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Robert J. Davidson

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FELLERS, SNIDER, BLANKENSHIP, BAILEY & TIPPENS, PC
100 BROADWAY
SUITE 1700
OKLAHOMA CITY, OK 73102-8820

EXAMINER

SHELEHEDA, JAMES R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/760,242	Applicant(s) DAVIDSON, ROBERT J.	
	Examiner JAMES SHELEHEDA	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 10 September 2009.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-5,8,9,11-15,19,20,24-26,32 and 37-39 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-5,8,9,11-15,19,20,24-26,32 and 37-39 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

On page 12, while applicant states that some pending claim language was not considered in the rejection of claim 9, no example was given as to what language applicant feels was not properly addressed.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8, 19, 20, 24, 25, 32, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (6,628,963) (of record) in view of Kawakami et al. (Kawakami) (7,266,202) (of record) and Lewis (US 2003/0040962 A1).

As to claim 1, while Chung discloses a method of portably handling entertainment media (column 1, lines 5-12) comprising:

storing in a memory of a portable digital storage module non-encoded entertainment media that is not encoded with any authorized usage condition (column 1, lines 37-40, column 2, line 56-column 3, line 20),

he fails to specifically disclose after the storing step is completed, encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.

In an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein non-encoded digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playings of the entertainment media are (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

Additionally, in an analogous art, Lewis discloses a content delivery system (paragraph 23) for controlling access to content (paragraph 203 and 207-209) where the access instructions are recorded after the content is downloaded into the storage device (paragraph 35, 203 and 254) for the typical benefit of allowing other distribution methods to be utilized by pre-recording the content onto the recording medium prior to rental or purchase by the user (paragraph 35, 203 and 254).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include encoding the portable digital storage module with access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Kawakami's system to include encoding the portable digital storage module with access instructions after the storing step is completed, as taught in combination with Lewis, for the typical benefit of allowing other distribution methods to be utilized by pre-recording the content onto the recording medium prior to rental or purchase by the user.

As to claim 2, Chung, Kawakami and Lewis disclose wherein the storing step further comprises transferring a copy of the non-encoded entertainment media from a purchase center into the memory of the portable digital storage module (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 3, Chung, Kawakami and Lewis disclose wherein the storing step further comprises downloading the non-encoded entertainment media from a remotely located database (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 4, Chung, Kawakami and Lewis disclose repeating the storing the entertainment media step to store two or more non-encoded entertainment media into the memory of the portable digital storage module (downloading and storing a plurality of movie files; see Chung at column 1, lines 5-12, lines 37-40 and column 2, lines 55-62).

As to claim 5, Chung, Kawakami and Lewis disclose wherein the retrieving step is characterized by the digital format player device including a personal movie player (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 8, Chung, Kawakami and Lewis disclose wherein the storing step is performed in a broadband frequency format (MPEG format; see Chung at column 2, line 35 - column 3, line 11).

As to claim 19, Chung, Kawakami and Lewis disclose wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media a finite number of times (see Kawakami at column 8, lines 17-24).

As to claim 20, Chung, Kawakami and Lewis disclose wherein the encoding step is characterized by the prescribed authorized usage condition granting permission to playback the stored non-encoded entertainment media within a finite period of time (see Kawakami at column 11, lines 19-28).

As to claim 24, Chung, Kawakami and Lewis discloses wherein the storing step is characterized by the non-encoded entertainment media comprising audio data (see Chung at column 1, lines 6-14).

As to claim 25, Chung, Kawakami and Lewis disclose wherein the storing step is characterized by the non-encoded entertainment media comprising video data (see Chung at column 1, lines 6-14).

As to claim 32, Chung, Kawakami and Lewis disclose wherein the encoding steps is characterized by automatically deleting the stored non-encoded entertainment media from the memory according to the prescribed authorized usage (see Kawakami at column 26, lines 1-20).

As to claim 37, Chung, Kawakami and Lewis disclose retrieving the stored non-encoded entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions (see Kawakami at column 8, lines 11-23).

As to claim 39, Chung, Kawakami and Lewis disclose after a request for usage of the stored non-encoded entertainment media, changing the encoded access instructions and thereby changing the prescribed authorized usage condition of the stored non-encoded entertainment media in relation to the request for a usage of the stored non-encoded entertainment media (see Kawakami at column 8, lines 18-24 and column 11, lines 19-28).

4. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Katayama et al. (Katayama) (6,651,212) (of record), Kawakami and Lewis.

As to claim 9, while Chung discloses a portable digital storage module (column 2, lines 55-62 and column 1, lines 37-40) comprising:

an enclosure that is removably engageable with each of a plurality of digital devices (flash memory or multimedia card; Fig. 3; column 2, lines 56-62) in a data transfer relationship (see Fig. 3; column 2, lines 50-60 and column 1, lines 34-40 and lines 56-62),

a memory in the enclosure (column 2, lines 50-62),

an interface configured to operably communicate with a first digital device of the plurality of digital devices to store to the memory of non-encoded entertainment media that is not encoded with any usage condition (inherently present as the memory device interfaces with and communicates with the digital device; column 1, lines 37-40, column 2, line 56-column 3, line 20), he fails to specifically disclose a controller in the enclosure configured to respond to access instructions that are encoded to the digital storage module via the interface after the non-encoded entertainment media has been stored to the memory to enable the interface to operably communicate with a second digital device of the plurality of digital device to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition.

In an analogous art, Katayama discloses wherein a removable flash memory device (Fig. 1; 101) comprising controller logic (102) for operating the storage device

and communicating between the memory component (111-114) and the communications interface (105-106) (Fig. 1; column 10, lines 10-37), the communication interface (see Katayama at Fig. 1) subject to the programmable controller (Fig. 1; column 10, lines 13-37) in transferring data from the memory to the digital format player device (see Katayama at Fig. 1; column 10, lines 13-37) for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip (column 2, lines 17-23).

Additionally, in an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playing of the entertainment media (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

Also, in an analogous art, Lewis discloses a content delivery system (paragraph 23) for controlling access to content (paragraph 203 and 207-209) where the access instructions are recorded after the content is downloaded into the storage device (paragraph 35, 203 and 254) where the content is recorded onto the storage device via communication with one digital device and where the content is played back via communication with a second digital device (paragraph 203, 254 and 257) for the typical benefit of allowing other distribution methods to be utilized by pre-recording the content

onto the recording medium prior to rental or purchase by the user (paragraph 35, 203 and 254).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung's system to include a controller in the enclosure for executing instructions stored in the memory, as taught in combination with Katayama, for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Katayama's system to include access instructions that are encoded to the digital storage module via the interface to enable the interface to operably communicate with a digital device to playback the non-encoded entertainment media in accordance with a prescribed authorized usage condition, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

Also, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung, Katayama and Kawakami's system to include encoding the portable digital storage module with access instructions after the storing step is completed, as taught in combination with Lewis, for the typical benefit of allowing other distribution methods to be utilized by pre-recording the content onto the recording medium prior to rental or purchase by the user.

As to claim 15, Chung, Katayama, Kawakami and Lewis disclose wherein the memory is configured for subsequently storing data wherein different data was previously stored (see Chung at column 2, lines 56-62).

5. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, Katayama, Kawakami and Lewis as applied to claim 9 above, and further in view of Gibson.

As to claim 11, while Chung, Katayama, Kawakami and Lewis disclose a memory, they fail to specifically disclose wherein the memory is characterized as an atomic resolution storage device comprising:

a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and

a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21), the atomic resolution storage device comprising a field emitter fabricated by semiconductor micro-fabrication techniques capable of generating an electron beam current (see Gibson at column 2, line 65 - column 3, line 29), and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the

storage area (see Gibson at column 3, lines 1-5) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung, Katayama, Kawakami and Lewis's system to include wherein the memory is characterized as an atomic resolution storage device comprising: a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area, as taught in combination with Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

As to claim 12, Chung, Katayama, Kawakami, Lewis and Gibson disclose an effect being generated when the electron beam current bombards the storage area, wherein the magnitude is dependent on the state of said storage, and wherein storage data is read by measuring the magnitude of the effect (see Gibson at column 5, line 64 - column 6, line 10).

As to claim 13, Chung, Katayama, Kawakami, Lewis and Gibson disclose the atomic resolution storage module further comprising a plurality of storage areas on the storage medium, each storage area in one of a plurality of states to represent

information stored in the storage area (see Gibson at column 5, line 64 – column 6, line 10), and a micro fabricated mover in the storage device for positioning various areas to be bombarded by the electron beam current (see Gibson at column 6, lines 2-10).

As to claim 14, Chung, Katayama, Kawakami, Lewis and Gibson disclose the atomic resolution storage module further comprising a plurality of said field emitters (see Gibson at column 2, line 65 - column 3, line 5), with each emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current (see Gibson at column 3, lines 5-20), with each emitter space apart, and with each emitter being responsible for a number of storage areas such that said emitters can function in parallel to increase the data rate of the storage device (see Gibson at column 3, line 57 - column 4, line 20).

6. Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, Kawakami and Lewis as applied to claim 1 above, and further in view of Downs et al. (Downs) (6,226,618) (of record).

As to claim 26, while Chung and Kawakami disclose storing access instructions and a purchase price, they fail to specifically disclose wherein the encoding step is characterized by a predetermined association between a user-selected purchase price for the non-encoded entertainment media and the corresponding authorized usage.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-

48) which is encoded with access instructions corresponding to a predefined limit of authorized playing of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) wherein the access instructions are characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage (usage tables; see Downs at columns 59 and 61) for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner (see Downs at columns 59 and 61).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Kawakami's system to include wherein the programming access instructions steps is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage, as taught in combination with Downs, for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner.

As to claim 38, Chung, Kawakami and Downs disclose the user selected purchase price being determined by a users input to a point of purchase system (see Downs at usage tables, column 59 and column 61), wherein the stored non-encoded entertainment media resides in the memory of the digital storage module prior to the user's input (see Downs at column 78, lines 28-67 and Lewis at paragraph 254).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Primary Examiner, Art Unit 2424

JS